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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/596,629      | 03/27/2007  | Karlheinz Herbold    | 034691/313122       | 8556             |

826 7590 07/31/2008

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| EXAMINER |
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MILLER, BENA B

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| ART UNIT | PAPER NUMBER |
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3725

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07/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/596,629 | <b>Applicant(s)</b><br>HERBOLD ET AL. |  |
|                              | <b>Examiner</b><br>Bena Miller       | <b>Art Unit</b><br>3725               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 24-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 24-38 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd (US Patent 5,467,931) in view of Staver (US Patent 464,592).

Dodd teaches most of the elements of the claimed invention including two grinding disks (fig.1) formed as a ring with a central hole disposed essentially parallel to one another and rotatable with respect to one another about a common axis which extends through the central holes of the disk (fig.1), a first working surface (28), a second working surface (30) and the first and second working surfaces provided with straight cutting teeth (fig.3). The examiner takes the position that the disks of Dodd are approximately of equal size and equal working surfaces, the outer edge section makes up approximately 30%-70% of radial extension of the grinding disks and the cutting teeth angle of 2 to 40 degrees relative approximately direction. Further, the examiner further takes the position that the disk mill of Dodd is configured for grinding hard materials, minerals, plastics, soft materials, wood pulps and foodstuffs. However, Dodd fails to teach the cutting teeth of the second working surfaces are inclined more sharply than the cutting teeth of the first working surfaces. Staver teaches two companion grinding rings, wherein one is stationary and the other revolving, having a portion of the

workings surface (d) with cutting teeth that are inclined more sharply than the cutting teeth of another portion of the working surface (j; fig. 4 and 5). It would have been obvious to one of ordinary skill in the art to have the cutting teeth of the second working surface inclined more sharply, as suggested by Staver, than the cutting teeth of the first working surface of Dodd for the purpose of providing a continuous feed, a positive reduction and final finish of the grinded material.

In the event Applicant disagrees with the Examiner's position that Dodd teaches the disks are approximately of equal size and equal working surfaces, the outer edge section makes up approximately 30%-70% of radial extension of the grinding disks and the cutting teeth angle of 2 to 40 degrees relative approximately direction, it would have been obvious to one of ordinary skill in the art to incorporate these features in the device of Dodd for the purpose providing disk with extended wear life.

### ***Response to Arguments***

Applicant's arguments filed 04/25/08 have been fully considered but they are not persuasive. In response to applicant's remarks to the rejection under 35 U.S.C. § 112, second paragraph, the examiner agrees and therefore, the rejections has been withdrawn.

In reference to applicant's remarks to the rejection under 35 U.S.C. § 103, the applicant argues that prior art fails to teach the limitation emphasized in lines 1 and 2 on page 7 of the Remarks, the examiner disagrees. The applicant further argues the demonstrated Figure 3 of the current application, shows the cutting teeth of the second working surface are inclined more sharply than the cutting teeth. In contrast, the

applicant argues, Staver teaches teeth j of the second workings surface are inclined less than the teeth d of the first working surface. It should be noted, the examiner indicated in the above rejection “a portion of the workings surface (g) with cutting teeth that are inclined more sharply than the cutting teeth of another portion of the working surface (j; fig. 4 and 5)”, i.e., the examiner considered the first working surface as element j of Staver. Therefore, the second working surface d is inclined more sharply than the cutting teeth of the first working surface j. Therefore, the examiner maintains the rejection.

For the reasons set forth above, this Office Action is made Final.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bena Miller/  
Primary Examiner, Art Unit 3725  
July 30, 2008